REMARKS/ARGUMENT

The specification has been amended to correct obvious errors, particularly in view of the disclosure of DE 10 058 616. Such amendments include identifying EP 0922671 at page 6, line 3.

Applicants respectfully submit that it is appropriate to incorporate by reference the priority document in this case. See, 37 C.F.R. § 1.57.

The abstract has also been amended. Applicants request amendment of the existing abstract by replacement abstract attached on a separate sheet to this amendment.

Claims 1 and 13 have been amended to require a low tamped density (20-70 g/l) and a high DBP number (350-400 g/100 g). Support for these amendments exists throughout the entire specification, including page 3, lines 13-15.

New claims 25 and 26 have been added. Support for these claims exists, *inter alia*, at page 3, line 14 of the present specification.

Claims 1-26 are currently pending.

The Office Action rejected claims 1-4 and 13-16 under 35 U.S.C. § 102 as anticipated by CA 2255456 ("Siray"), and claims 6-12 and 17-24 under 35 U.S.C. § 103 as obvious over U.S. patent 5,034,207 ("Kerner") in view of Siray. In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

The claimed invention relates to precipitated silica having a low tamped density (20-70 g/l) and a high DBP number (350-400 g/100 g). The cited art neither teaches nor suggests such silica having both of these characteristics, let alone all of the elements required by the claims.

Specifically, the Office Action (in the line bridging pages 5-6) recognized that Kerner does not teach or suggest the claimed precipitated silica. Similarly, Siray does not teach or suggest the required silica.

Siray discloses silica having a tamped density between 70-90 g/l and a DBP number of 300-360 g/100 g. Thus, a small amount of overlap exists (1) at a single point for tamped density (70 g/l); and (2) over a small range for DBT number (350-360 g/100 g). Although a small amount of overlap exists, the claimed ranges for tamped density and DBP number includes numerical values which are neither taught nor suggested by Siray (that is, tamped density less than 70 g/l and DBP number greater than 360 g/100 g). Also, Siray's tamped value range (70-140 g/l) is higher than the claimed range, reaching values of up to 2 to 7 times greater than the values in the claimed range. Under such circumstances, Siray cannot necessarily lead one skilled in the art to the claimed silica having the low, claimed tamped density range and the high, claimed DBP number range. Accordingly, Siray cannot constitute an anticipatory reference as a matter of law. Atofina v. Great Lakes Chemical Corp., 441 F.3d 991 (Fed. Cir. 2006) (copy enclosed).

Furthermore, as demonstrated in the attached Rule 132 declaration (at par. 2), none of Siray's examples disclose precipitated silica having a tamped density of 20-70 g/l or a DBP number of 350-400 g/100 g, let alone precipitated silica having both of these characteristics. Thus, Siray does not inherently disclose the claimed silica.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102.

Regarding the rejection under § 103, because neither of the cited references teaches or suggests the claimed silica, their combination cannot yield the claimed silica. For this reason alone, Applicants respectfully submit that no *prima facie* case of obviousness exists, and that the § 103 should be withdrawn.

Moreover, nothing in either of the references would have motivated one skilled in the art to modify the silica disclosed therein to arrive at the claimed precipitated silica. More specifically, nothing in either of the cited references would lead one skilled in the art to the claimed precipitated silica having both low tamped density (20-70 g/l) and high DBP number (350-400 g/100g). Following the preparation methods set forth in Siray, one skilled in the art would obtain silica having tamped density of 72-85 g/l and a DBP number of 320-333 g/100g, (see, Rule 132 declaration, par. 3), and no teaching or suggestion exists in either of the cited references concerning how to modify the preparation methods to achieve precipitated silica having both low tamped density (20-70 g/l) and high DBP number (350-400 g/100g). (See, Rule 132 declaration, pars. 3-4). In other words, following Siray would not lead one skilled in the art to the claimed silica, and nothing in Kerner compensates for Siray's deficiencies. For this reason as well, Applicants respectfully submit that no *prima facie* case of obviousness exists, and that the § 103 should be withdrawn.

Finally, even assuming that a *prima facie* case of obviousness exists (which, as explained above, is not the case), sufficient data demonstrating superior and beneficial results associated with the claimed silica are disclosed in the present application to rebut any such hypothetical case of obviousness. More specifically, as demonstrated on page 7 of the present application, the invention silicas possess improved matting efficiency over comparative silicas.

As explained in the attached Rule 132 declaration, examples 1, 3, 4 and 5 correspond to the invention silicas. (See, Rule 132 declaration, par. 5). These examples all have gloss 60° values which are surprisingly lower than the gloss value of Example 2 (DBP number of 333 g/100 g) and the comparative composition containing Acematt HK 450. (See, Rule 132 declaration, par. 5). This difference in matting efficiency between the invention silicas and the comparative silicas was surprising and unexpected given the similarity of the silicas. (See, Rule 132 declaration, par. 6).

The improved matting efficiency obtained with the claimed silicas are representative of the present invention. (See, Rule 132 declaration, par. 7). That is, it would be expected that precipitated silicas having the following characteristics

BET	350 - 550 m^2/g
DBP number	350 - 400 g/100 g
d_{50}	5 - 15 μm, and
tamped density	20 - 70 g/l.

would possess improved matting efficiency like those of the exemplified invention silicas. (See, Rule 132 declaration, par. 7).

The difference in matting efficiency between the invention silicas and the comparative silicas demonstrates the surprising and unexpected benefit derived from having properties associated with the invention silicas. (See, Rule 132 declaration, par. 8). What's more, the improved matting efficiency associated with the invention silicas are commercially significant -- clearly, silicas which possess more effective matting properties are more commercially viable than less effective silicas. (See, Rule 132 declaration, par. 9).

In view of the above, Applicants respectfully submit that sufficient data exists demonstrating the unexpected and surprising matting properties of the claimed silicas to rebut any hypothetical *prima facie* case of obviousness which might exist.

For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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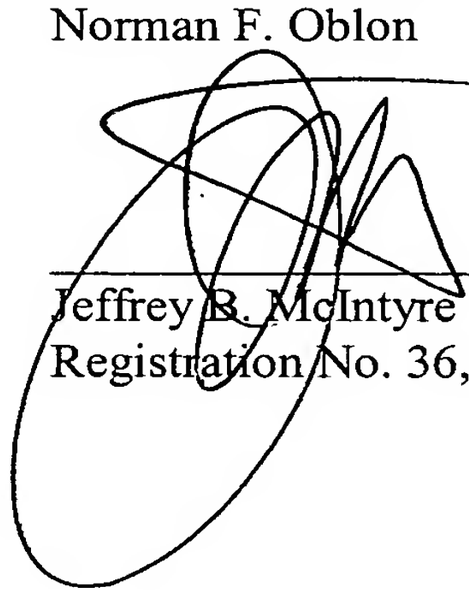

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